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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,735	09/18/2003	Philip J. Palermo	200.1113CON2	4665

7590 05/09/2005

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EXAMINER	
WEDDINGTON, KEVIN E	

ART UNIT	PAPER NUMBER
1614	

DATE MAILED: 05/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/665,735	PALERMO ET AL.	
	Examiner	Art Unit	
	Kevin E. Weddington	1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 November 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *12-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *12-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *11-3-04* and 7-6-04.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Claims 12-23 are presented for examination.

Applicants' information disclosure statements filed July 6, 2004 and November 3, 2004 have been received and entered.

Applicants' election filed November 3, 2004 in response to the restriction requirement of August 30, 2004 has been received and entered. The applicants elected the invention described in claims 12-23 and cancelled claims 1-11.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 12-17 and 21-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5-7, 11, 22, 24, 25 and 28 of U.S. Patent No. 6,228,863. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented application teaches a method of reducing the abuse potential of an oral dosage form of an opioid analgesic, comprising

combining an analgesically effective amount of an orally active opioid agonist together with an opioid antagonist into an oral dosage form, said opioid agonist/antagonist combination being chosen such that the opioid agonist and opioid antagonist are only extractable form the dosage form together, and at least a two-step extraction process is required to separate the opioid antagonist from the opioid agonist, the amount of opioid antagonist including being sufficient to counteract opioid effects if extracted together from the oral dosage form together with the opioid agonist and administered parentally; and the present application teaches an oral dosage form comprising an analgesically effective amount of an orally active opioid agonist and naltrexone (opioid antagonist), wherein the said opioid agonist and naltrexone or pharmaceutically acceptable salt thereof being chosen such that the opioid agonist and the naltrexone or pharmaceutically acceptable salt thereof are only extractable from the dosage form together, and at least a two-step extraction process is required to separate the opioid agonist from the naltrexone or pharmaceutically acceptable salt thereof, the amount of naltrexone or pharmaceutically salt thereof included being sufficient to counteract opioid effects if extracted from the oral dosage form together with the opioid agonist and administered parenterally. The method of the patented application requires the composition of the present application in order to produce the intended use. The composition of the present application is obviously needed to

use the patented method. Applicants were not prevented from drafting claims to the product itself.

Claims 12-17 and 21-22 are not allowed.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 12-15 and 20-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5-7, 12, 13 and 16 of U.S. Patent No. 6,627,635. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented application teaches a method of reducing the abuse potential of an oral dosage form of an opioid analgesic, comprising combining an analgesically effective amount of an orally active opioid agonist together with an opioid antagonist and a sustained release carrier into an oral dosage form, said dosage form providing a release of said opioid analgesic for about 12 to 24

hours; said opioid agonist/antagonist combination being chosen such that the opioid agonist and opioid antagonist are only extractable form the dosage form together, and at least a two-step extraction process is required to separate the opioid antagonist from the opioid agonist, the amount of opioid antagonist including being sufficient to counteract opioid effects if extracted together from the oral dosage form together with the opioid agonist and administered parentally; and the present application teaches an oral dosage form comprising an analgesically effective amount of an orally active opioid agonist and naltrexone (opioid antagonist), wherein the said opioid agonist and naltrexone or pharmaceutically acceptable salt thereof being chosen such that the opioid agonist and the naltrexone or pharmaceutically acceptable salt thereof are only extractable from the dosage form together, and at least a two-step extraction process is required to separate the opioid agonist from the naltrexone or pharmaceutically acceptable salt thereof, the amount of naltrexone or pharmaceutically salt thereof included being sufficient to counteract opioid effects if extracted from the oral dosage form together with the opioid agonist and administered parenterally. The method of the patented application requires the composition of the present application in order to produce the intended use. The composition of the present application is obviously needed to use the patented method. Applicants were not prevented from drafting claims to the product itself.

Claims 12-15 and 20-23 are not allowed.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 12, 17, 20 and 21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 12, 14 and 19 of Kaiko et al., U.S. Patent No. 6,475,494 in view of Palermo et al., U.S. Patent No. 6,228,863.

Claims 12, 17, 20 and 21 teaches an oral dosage form comprising an analgesically effective amount of an orally active opioid agonist and naltrexone (opioid antagonist), wherein the said opioid agonist and naltrexone or pharmaceutically acceptable salt thereof being chosen such that the opioid agonist and the naltrexone or pharmaceutically acceptable salt thereof are only extractable from the dosage form together, and at least a two-step extraction process is required to separate the opioid agonist from the naltrexone or pharmaceutically acceptable salt thereof, the amount of naltrexone or

pharmaceutically salt thereof included being sufficient to counteract opioid effects if extracted from the oral dosage form together with the opioid agonist and administered parenterally. The Kaiko et al. patent teaches an oral dosage form comprising an orally therapeutically effective dose of an opioid agonist, and an opioid antagonist, the dosage form having a ratio of opioid antagonist to opioid agonist that provides a combination product, which is analgesically effective when the combination is administered orally. The secondary reference, Palermo et al., teaches in claims 1, 5-7, 11, 22, 24, 25 and 28 a method of reducing the abuse potential of an oral dosage form of an opioid analgesic, comprising combining an analgesically effective amount of an orally active opioid agonist together with an opioid antagonist into an oral dosage form, said opioid agonist/antagonist combination being chosen such that the opioid agonist and opioid antagonist are only extractable form the dosage form together, and at least a two-step extraction process is required to separate the opioid antagonist from the opioid agonist, the amount of opioid antagonist including being sufficient to counteract opioid effects if extracted together from the oral dosage form together with the opioid agonist and administered parentally, note the two-step extraction process. The claims in Kaiko et al. patent combined with the claims and teachings of Palermo et al. patent would have made the current claims an obvious variation because it would have been obvious to have combine the composition comprising an opioid agonist and an opioid antagonist in the Kaiko et al. patent in the method of having a two-step

extraction process to separate the opioid antagonist from the opioid agonist in the absence of evidence to the contrary.

Claims 12, 17, 20 and 21 are not allowed.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 12, 16, 20 and 22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4, 6, 12 and 14 of Kaiko et al., U.S. Patent No. 6,696,066 in view of Palermo et al., U.S. Patent No. 6,228,863.

Claims 12, 16, 20 and 22 teaches an oral dosage form comprising an analgesically effective amount of an orally active opioid agonist and naltrexone (opioid antagonist), wherein the said opioid agonist and naltrexone or pharmaceutically acceptable salt thereof being chosen such that the opioid agonist and the naltrexone or pharmaceutically acceptable salt thereof are only

extractable from the dosage form together, and at least a two-step extraction process is required to separate the opioid agonist from the naltrexone or pharmaceutically acceptable salt thereof, the amount of naltrexone or pharmaceutically salt thereof included being sufficient to counteract opioid effects if extracted from the oral dosage form together with the opioid agonist and administered parenterally. The Kaiko et al. patent teaches an oral dosage form comprising an orally therapeutically effective dose of an opioid agonist, and an opioid antagonist, the dosage form having a ratio of opioid antagonist to opioid agonist that provides a combination product, which is analgesically effective when the combination is administered orally. The secondary reference, Palermo et al., teaches in claims 1, 5-7, 11, 22, 24, 25 and 28 a method of reducing the abuse potential of an oral dosage form of an opioid analgesic, comprising combining an analgesically effective amount of an orally active opioid agonist together with an opioid antagonist into an oral dosage form, said opioid agonist/antagonist combination being chosen such that the opioid agonist and opioid antagonist are only extractable form the dosage form together, and at least a two-step extraction process is required to separate the opioid antagonist from the opioid agonist, the amount of opioid antagonist including being sufficient to counteract opioid effects if extracted together from the oral dosage form together with the opioid agonist and administered parentally, note the two-step extraction process. The claims in Kaiko et al. patent combined with the claims and teachings of Palermo et al. patent would

have made the current claims an obvious variation because it would have been obvious to have combine the composition comprising an opioid agonist and an opioid antagonist in the Kaiko et al. patent in the method of having a two-step extraction process to separate the opioid antagonist from the opioid agonist in the absence of evidence to the contrary.

Claims 12, 16, 20 and 22 are not allowed.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 12-23 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an oral dosage form comprising an orally active opioid agonist such as hydrocodone bitartrate, hydromorphone hydrochloride and oxycodone hydrochloride combined individually with naltrexone, does not reasonably provide enablement for other orally active opioid agonists such as morphine sulfate, disclosed in claims 15 and 19. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

In this regard, the application disclosure and claims have been compared per factors indicated in the decision In re Wands, 8 USPQ2d 1400 (Fed. Cir., 1988) as to undue experimentation.

The factors include:

1) the quantity of experimentation necessary

2) the amount of direction or guidance provided

3) the presence or absence of working examples

4) the nature of the invention

5) the state of the art

6) the relative skill of those in the art

7) the predictability of the art and

8) the breadth of the claims

The instant specification fails to provide guidance that would allow the skilled artisan background sufficient to practice that instant invention without resorting to undue experimentation in view of further discussion below.

The nature of the invention, state of the prior art, relative skill of those in the art and the predictability of the art

The claimed invention related to an oral dosage form comprising:

i) an analgesically effective amount of an orally active opioid agonist; and

ii) naltrexone or a pharmaceutically acceptable salt thereof

and at least a two-step extraction process is required to separate the opioid agonist from the naltrexone or pharmaceutically salt thereof.

The relative skill of those in the art is generally that of a Ph.D. or M.D.

The present invention is unpredictable unless experimentation is shown for the other orally active opioid agonists including morphine.

The breadth of the claims

The claims are very broad and inclusive to all orally active opioid agonists combined with naltrexone.

The amount of direction or guidance provided and the presence or absence of working examples

The working examples are limited to the administration of hydrocodone bitartrate, hydromorphone hydrochloride and oxycodone hydrochloride combined individually with naltrexone.

The quantity of experimentation necessary

Applicants have failed to provide guidance as to how the other orally active opioid agonists are combined with naltrexone and the level of experimentation needed to determine the other orally active opioid agonists combined with naltrexone will achieve the intended function is undue. Therefore, undue experimentation would be required to practice the invention as it is claimed in its current scope.

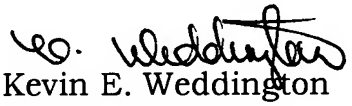
Claims 12-23 are not allowed.

In claim 12, line 7, the word "antagonist" should be changed to –agonist--, because how can you separate an opioid antagonist from naltrexone (an opioid antagonist) from itself.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin E. Weddington whose telephone number is (571)272-0587. The examiner can normally be reached on 11:00 am-7:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (571)272-0951. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kevin E. Weddington
Primary Examiner
Art Unit 1614

K. Weddington
May 4, 2005